

REMARKS

STATUS:

The Office Action dated April 17, 2008 (the "Office Action"), has been carefully reviewed. Claims 1-16 are pending in this application. Claims 1-2 and 15 have been amended. Reconsideration of this application is respectfully requested.

35 USC § 102 REJECTIONS:

Claims 1, 8, 11, and 13 were rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 6,473,153 to Iguchi et al. (hereinafter "Iguchi"). As discussed below, the rejection of claims 1, 8, 11, and 13 as being anticipated by Iguchi is believed to be overcome.

Discussion Regarding Patentability of Claim 1 and Claims 8, 11, and 13 Dependent Thereon

Claim 1, as currently amended, recites the following limitations:

printing a confirmation for confirming to a user that said each image on which said first action to be taken is designated; and
following printing said confirmation, performing said first action based on said detecting said first designation mark.

The image print guide in Iguchi does not include the step of "printing a confirmation for confirming to a user that said each image on which said first action to be taken is designated; and following printing said confirmation, performing said first action based on said detecting said first designation mark", as claimed in claim 1, as currently amended.

The Examiner refers to col. 24, 11. 5-16 of Iguchi as support for his allegation that Iguchi teaches "printing a confirmation for confirming to a user that said each image on which said first action to be taken." The Examiner states that "The printing of print P3 is construed as a

confirmation because it confirms to the user that each image on which the first action to be taken is designated.”

Col. 24, 11. 5-16 of Iguchi recites the following”

The image processing apparatus 100 provides image processing of the instruction information written in the instruction information writer 11h corresponding to the frame image 10h of the guide print P2 when the guide print P2 is read in advance, thereby obtaining information on the number of prints and print size specified therein. Then based on instruction information, the photographic print P3 provided with trimming in conformity to the designation information (frame line F) of the trimming region is automatically produced in the number of prints and print size desired by the customer, when the photographic print P3 is produced. The work of the photofinishing lab is now complete

The “printing of print P3” is “performing said first action”, which is not the same as “printing a confirmation for confirming to a user that said each image on which said first action to be taken is designated; and following printing said confirmation, performing said first action”. Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since the image print guide of Iguchi does not disclose each and every element of Applicant’s claim 1, as currently amended, Iguchi does not anticipate claim 1, as currently amended. Therefore, the rejection of claim 1 under 35 U.S.C. 102(b) has been overcome.

Claims 8, 11, and 13 depend directly or indirectly from amended claim 1. As a result, claims 8, 11, and 13 are allowable for at least the reasons hereinbefore discussed with regard to currently amended claim 1.

The rejection of claims 1, 8, 11, and 13 under 35 USC §102(b) as being anticipated by Iguchi is believed to be overcome and the removal of the rejection to claims 1, 8, 11, and 13 under 35 USC §102(b) as being anticipated by Iguchi is hereby requested.

35 USC §103 REJECTIONS:

The Rejection of Claims 9-10, 12 and 14 Under 35 U.S.C. § 103(a) Should be Withdrawn

Claims 9-10, 12 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Iguchi in view of U.S. Patent No. 7,009,726 to Lumley (hereinafter “Lumley”). Reconsideration of the rejection under 35 U.S.C. § 103(a) to claims 9-10, 12 and 14 in view of the following remarks is respectfully requested.

Claims 9-10, 12 and 14 depend directly or indirectly from amended claim 1. As a result, claims 9-10, 12 and 14 are allowable for at least the reasons hereinbefore discussed with regard to amended claim 1, since Lumley does not overcome the deficiencies of Iguchi with respect to amended claim 1.

The rejection of claims 9-10, 12 and 14 under 35 USC §103(a) as being unpatentable over Iguchi in view of Lumley is believed to be overcome and the removal of the rejection to claims 9-10, 12 and 14 under 35 USC §103(a) as being unpatentable over Iguchi in view of Lumley is hereby requested.

The Rejection of Claim 16 Under 35 U.S.C. § 103(a) Should be Withdrawn

Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Iguchi in view of U.S. Patent No. 4,905,090 to Miyake (hereinafter “Miyake”). Reconsideration of the rejection under 35 U.S.C. § 103(a) to claim 16 in view of the following remarks is respectfully requested.

Claim 16 depends directly from amended claim 1. As a result, claim 16 is allowable for at least the reasons hereinbefore discussed with regard to amended claim 1, since Miyake does not overcome the deficiencies of Iguchi with respect to amended claim 1.

The rejection of claim 16 under 35 USC §103(a) as being unpatentable over Iguchi in view of Miyake is believed to be overcome and the removal of the rejection to claim 16 under 35 USC §103(a) as being unpatentable over Iguchi in view of Miyake is hereby requested.

ALLOWABLE SUBJECT MATTER

The applicants note with appreciation the allowability of claims 2-7 and 15 if rewritten in independent form including all the limitations of the base claim and any intervening claims. Claims 2 and 15 were amended as to be rewritten in independent form including all the limitations of the base claim and any intervening claims, as suggested by the Examiner and, as such, are believed to be in allowable form. Claims 3-7 depend directly or indirectly on rewritten claim 2 and are, as such, believed to be in allowable form, as well.

SUMMARY

For the foregoing reasons, Applicants submit that no combination of the cited references teaches, discloses, arrives at, or suggests the subject matter of the pending claims. The pending claims are therefore in condition for allowance, and Applicants respectfully request withdrawal of all rejections and allowance of the claims.

In the event Applicant has overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicant hereby conditionally petitions therefor and authorizes that any charges be made to Deposit Account No. 20-0095, TAYLOR & AUST, P.C.

Should any question concerning any of the foregoing arise, the Examiner is invited to telephone the undersigned at (574) 897-3400.

Respectfully submitted,

/John S. Wagley, Reg. No. 36043/

John S. Wagley
Registration No. 36,043
Attorney for Applicant

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TAYLOR & AUST, P.C.
12029 E. Washington Street
Indianapolis, IN 46229
Telephone: 317-894-0801
Facsimile: 317-894-0803

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